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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW VARGA, ERNEST BURGER, GHASSAN CHIDIAC,
and GIANCARLO PALESCHI

Appeal 2009-004025
Application 09/847,557
Technology Center 3600

Decided: September 11, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed a bill of material assist tool that provides a method and system for managing parts requirements processes, including aggregating key information necessary for component selection and generating a complete and accurate bill of material from this information (Spec. 3:18-25). Claim 34, reproduced below, is representative of the subject matter of appeal.

34. A method for managing parts requirements processes in an engineering environment, comprising:

[1] receiving a bill of material including a list of component parts in response to a product design conducted on a workstation, wherein the bill of material for the product design can be edited to facilitate production planning processes for at least one of developing or manufacturing the product design;

[2] mapping each component part in the list to corresponding part selection process information, the corresponding part selection process information acquired from a plurality of external sources; and

[3] generating a summary resulting from the mapping;

wherein for each of the component parts in the list, the corresponding part selection process information includes at least one of:

a lead time; a current supply status; at least one supply source;
a cost; an end-of-life data; and a preferredness rating.
(Bracketing and numbering added).

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Swanson	US 2002/0184111 A1	Dec. 5, 2002
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The following rejections are before us for review:

1. Claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 are rejected under 35 U.S.C. § 103(a) as unpatentable over Swanson.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Swanson to include claim limitation [1] as identified in the claim above.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:¹

FF1. Swanson has disclosed a product e-catalog system that provides for the electronic creation, management, and viewing of product information using a multimedia display system (Title and Abstract).

FF2. Swanson discloses that products are made up of parts or components. A bill of material for a product lists its parts. Each part may have a list of accessories (options) for that part. Offering the users accessories at design time enhances the chance that the user will purchase additional options [0067].

FF3. Swanson discloses that the system allows for a hierarchal decomposition into bills of materials [0099].

FF4. Swanson discloses that the system allows for the configuration of systems composed of products having components. As components are added to the system, the graphics window 310 is re-rendered to show the added component. 3D animations provide for views of working components (e.g. a cabinet door opening and closing). The view also displays units (e.g. dimensions, costs, weights) along with a process for converting among various representations of the units (e.g. inches, feet, meters, etc). [0101]

FF5. Swanson discloses that the view allows for “add-on” products to be displayed and configured into the system being designed. [0103].

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415, (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The operative question in this “functional approach” is thus “whether the

improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Appellants argue that the rejection of claims 1, 34, and 35 is improper because it would not have been obvious to modify Swanson to include the claim limitation [1] as identified above (Br. 5-7). The Appellants argue that since Swanson is directed to selling available products to customers who are not responsible for designing the products they are purchasing, it would be counter-intuitive, and non-obvious for Swanson to be modified to provide customers with the capability of changing a bill of materials listing component parts (Br. 7).

In contrast the Examiner has determined that it would have been obvious to one of ordinary skill in the art to modify Swanson to be able to edit the bill of materials to facilitate a variety of planning processes, including cost planning inventory management, supplier approval, and production planning (Ans. 4).

We agree with the Examiner. In *KSR*, the Supreme Court rejected the Federal Circuit’s rigid application of its teaching, suggestion, motivation test in favor of an expansive and flexible approach. *Id.*, 550 U.S. at 415. The Supreme Court noted that often, it will be necessary “to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.*, 550 U.S. at 418. The Supreme Court noted that “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*, 550 U.S. at 418.

Here, Claim 1 requires in part:

[R]eceiving a bill of material including a list of component parts in response to a product design conducted on a workstation, wherein the bill of material for the product design can be edited to facilitate production planning processes for at least one of developing or manufacturing the product design.

Swanson has disclosed a product e-catalog system that provides for electronic creation and viewing of product information using a multimedia display system (FF1). Swanson has disclosed that products are made up of parts or components and that a *bill of material for a product lists its parts*. Swanson also discloses that each part may have a list of accessories (options) for that part and that *offering the users accessories at design time* enhances the chance that the user will purchase additional options (FF2). Swanson discloses that a view *allows for “add-on” products to be displayed*

and configured into the system being *designed* (FF5). Swanson also has disclosed that a view also displays units (e.g. dimensions, *costs*) along with a process for converting among various representations of the units (e.g. inches, feet, meters, etc) (FF4). Thus Swanson discloses that the catalog is used in a *product design* capability and that “add-on” products can be displayed and configured into the system being designed. As Swanson’s system also uses a bill of materials, the bill of materials would likely have been edited to reflect the new price with add-ons, and if such a reflection of the bill was not inherent, modifying the bill to reflect the updated price of the product add-ons would have been obvious to keep track of costs in cost planning. For these reasons the rejection of claims 1, and claims 34-35 which the Appellant has not argued separately, is sustained. The Appellants have also not argued for dependent claims 2-9, 11-15, 17-19, 21, 23-27, 29-31, and 33 separately and the rejection of these claims is accordingly sustained for these same reasons.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 under 35 U.S.C. § 103(a) as unpatentable over Swanson.

DECISION

The Examiner's rejection of claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 is sustained.

AFFIRMED

MP

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